

## **REMARKS**

Upon entry of the present amendments, claims 23-52 and 54-68 are pending in this application. No new matter has been introduced by the amendments, and their entry is respectfully requested. Amendments to the claims (a) correct obvious typographical errors and/or (b) render moot the rejections of the Examiner. Support for these amendments can be found in the application as originally filed and in the claims as originally filed.

By the amendments, Applicant does not acquiesce to the propriety of any of the Examiner's rejections and does not disclaim any subject matter to which Applicant is entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Further, Applicant reserves the right to prosecute the subject matter of any canceled claim in one or more continuation, continuation-in-part, or divisional applications.

### **Objections Under 37 CFR § 1.75 Should be Withdrawn**

The Examiner contends that should Claim 23 be found allowable, claim 53 or 62 will be objected to as being a substantial duplicate thereof and would be subject to objection under 37 C.F.R. § 1.75. Applicant respectfully disagrees.

In order to expedite prosecution of this application, Claim 53 has been cancelled without prejudice. However, claim 62 has not been cancelled.

Claim 62 is directed to a method of treating a neovascular eye condition associated with angiogenesis in a human or animal comprising administering to said human or animal a pharmaceutically effective amount of *a composition* comprising EM-138 or a hydrolysis product or metabolite thereof. Claim 62 therefore differs from claim 23, which only requires the administration of EM-138. Because the two claims differ in scope, the objection under 37 CFR § 1.75 should be withdrawn.

It is also alleged in the Office Action that Claim 63 is a substantial duplicate of claim 24; Claim 64 would be a substantial duplicate of claim 25; and claim 65 would be a substantial duplicate of claim 26. As these claims depend on claims 23 and 62, they are not substantial duplicates for the reasons stated above. Thus, Applicant respectfully requests that this objection under 37 C.F.R. § 1.75 be also withdrawn.

### **The Rejection under 35 U.S.C. § 112 Should be Withdrawn**

The Examiner maintains a rejection of claims 23-68 under 35 U.S.C. § 112, paragraph 1. Office Action at page 3. The Examiner contends that the claims "contain

subject matter ... not described in the specification.” Specifically, the Examiner asserts that “hydrolepis [sic] product or a metabolite” fails to find basis in the specification as filed. Applicant respectfully disagrees. However, in order to expedite the progress of this application, claims 23 and 62 are amended to recite “an epoxide or a hydrolysis product of an epoxide thereof” rather than “a hydrolysis product or a metabolite.” Support for these amendments may be found, e.g., in paragraphs 67 and 68 of the application as filed and published. In view of these amendments, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

In sum, Applicant respectfully submits that the claims are allowable. An early allowance of the application is respectfully requested.

Respectfully submitted,

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